

Appl. No.: 10/040,462
Docket No.: 0717-0488P
Reply to Office Action of December 16, 2003

REMARKS

Claims 1-10 are pending in this application. Claims 1-3 and 5-10 are independent claims. By this amendment, claims 1-3, 5 and 6 are amended, and new claims 7-10 are added.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

Allowable Subject Matter

The Office Action indicates that claims 2-4 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully points out that claims 2 and 3 are rewritten in independent form including all of the limitations of the base claim and any intervening claims. As such, claims 2-4 are in condition for allowance.

In addition, applicant respectfully submits that all of claims 1-10 are allowable, for at least the reasons set forth below.

The Claims Define Patentable Subject Matter

The Office Action expressly rejects claims 1, 5 and 6 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,236,390.

However, a close review of the body of the Examiner's rejection reveals that the Examiner is actually rejecting claims 1, 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,542,161 to Koyama et al. in view of U.S. Patent No.

Appl. No.: 10/040,462
Docket No.: 0717-0488P
Reply to Office Action of December 16, 2003

6,236,390 to Hitchcock and further in view of Applicant's Admitted Prior Art (AAPA). (see Office Action, pages 2-3, section 2). This rejection is respectfully traversed.

Koyama is Disqualified as Prior Art

Applicant respectfully points out that the main reference being relied upon by the Examiner, i.e., Koyama et al, shares a common assignee as with the present application, i.e., Sharp Kabushiki Kaisha.

As such, according to MPEP §707.02(k) and §706.02(1)(1), subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now *disqualified as prior art* (emphasis added) against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

In other words, because the present application was filed after November 29, 1999 and has common ownership with the Koyama et al reference, which has an 102(e) effective filing date, Koyama et al. is excluded as prior art because it is a commonly owned 35 U.S.C. 102(e) prior art, in a rejection under 35 U.S.C. 103 in the present application.

As such, as is evidenced by the Assignment papers filed on January 9, 2002 in the present application, which depict "Sharp Kabushiki Kaisha" as the common owner between the present application and the cited Koyama et al. (USP 6,542,161) reference,

Appl. No.: 10/040,462
Docket No.: 0717-0488P
Reply to Office Action of December 16, 2003

applicant respectfully requests the disqualification of Koyama et al. as prior art in the present case.

Hitchcock & AAPA Fail to make up for deficiencies/disqualification of Koyama et al.

Applicant respectfully submits that both Hitchcock and AAPA fail to make up for the deficiencies/disqualification of Koyama et al.

For example, claim 1 recites a character display apparatus for displaying an italic character. The features of the character display device is to display an italic character with at least the following three steps:

- 1) acquiring a first bit map which represents a basic portion of a character, the dots in the first bit map corresponding to sub-pixels of the display device;
- 2) performing predetermined conversion of the first bit map to generate a second bit map which represents a basic portion of an italic character, the dots in the second bit map corresponding to sub-pixels of the display device;
- 3) setting the intensity of a color element of a sub-pixel corresponding to the basic portion of the italic character to a predetermined value and setting the intensity of a color element of a sub-pixel adjacent to the sub-pixel corresponding to the basic portion of the italic character to a value different from the predetermined value based on the second bit map.

In the present invention, by performing steps 1) through 3) sequentially as described above, it becomes possible to display an italic character such that the basic portion of the italic character appears to the human eye to be not in a zigzag form but in a smooth linear form. This is possible because apparent centers of sub-pixels can be shifted in right/left directions by appropriately setting the intensity of the color element of the sub-pixel adjacent to the sub-pixel corresponding to the basic portion of the italic character in step 3).

Even if Koyama was not disqualified as prior art, Koyama et al. fails to teach or suggest sequentially performing the steps in a particular order as defined in claim 1 (i.e., from steps 1) through 3)), since Koyama et al. does not describe displaying an italic character, as admitted by the Examiner in the Office Action.

Also, Hitchcock fails to teach or suggest sequentially performing the steps in a particular order as defined in claim 1 (i.e., from steps 1) through 3)), since Hitchcock fails to refer to the step "to generate a bit map which represents a basic portion of an italic character".

The Examiner alleges that the technique disclosed in Hitchcock (technique for positioning characters) teaches the above-noted feature. However, the Examiner's allegation is wrong for at least the following reasons:

First of all, the technique disclosed in Hitchcock is a technique for adjusting a displayed position of a character which is not an italic character or a width of a character which is not an italic character.

Applicant respectfully submits that it cannot be regarded that Hitchcock describes to generate a bit map which represents an italic character because Hitchcock only discloses to adjust a displayed position of a character which is not an italic character or a width of a character which is not an italic character and to generate a bit map which represents a character which is not in italics.

Furthermore, in Hitchcock, even when a displayed position of a character which is not an italic character or a width of a character which is not an italic character is adjusted, a bit map which represents an italic character cannot be generated.

Furthermore, applicant respectfully submits that AAPA (Applicant's Admitted Prior Art) fails to make up for the deficiencies found in both Koyama et al. and Hitchcock.

Regarding claims 5 and 6

Claims 5 and 6 recite steps 1) through 3) as recited in claim 1. Therefore, the same arguments as presented above for claim 1 are equally applicable to claims 5 and 6.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

Appl. No.: 10/040,462
Docket No.: 0717-0488P
Reply to Office Action of December 16, 2003

claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that even if Koyama was not disqualified as prior art, the combination of Koyama, Hitchcock and AAPA still fail to teach or suggest each and every feature as set forth in the claimed invention, for at least the reasons set forth above.

As such, applicant respectfully submits that independent claims 1 and 5-10 are all allowable over the combination of Koyama, Hitchcock and AAPA, for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1, 5 and 6 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Applicants respectfully petition under the provisions of 37 C.F.R. §1.136(a) and §1.17 for an one (1) month extension of time in which to respond to the Examiner's Office Action. The appropriate Extension of Time Fee is attached hereto.

Appl. No.: 10/040,462
Docket No.: 0717-0488P
Reply to Office Action of December 16, 2003

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,
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0717-0488P